

REMARKS

Claims 1, 3-7, 9-11, 13-19, 23, and 25-28 are pending in the application. Claims 1, 3, 11, 19, and 26-28 are presently amended. The amendments find support throughout the specification as originally filed, for example, at page 6, line 16 through page 7, line 9, as well as in Table 1 on page 7. No new matter is entered into the application by the addition of the aforementioned amendments and claims.

REJECTIONS UNDER § 112, FIRST PARAGRAPH

In the Office Action, claims 1, 3, 11, 19, and 26-28 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Claim 3 was amended to clarify that the groups listed are the groups that relate to the term “hydrocarbyl” as set forth in claim 1 rather than other undefined groups. It is believed that the amendment of claim 3 overcomes the rejection.

Also, applicants have amended the claims 1, 11, 19, and 26-28 in accordance with the examiner’s suggestions. It is believed that the currently amended claims 1, 3, 11, 19, and 26-28 now fulfill the statutory requirements of 35 U.S.C. 112, and are in a condition suitable for allowance. Reconsideration and withdrawal of the rejections of claims 1, 3, 11, 19, and 26-28 35 U.S.C. §112, first paragraph are hereby respectfully requested.

REJECTION UNDER § 102(b)

In the Office Action, claims 1, 3-7, 9-11, 13-19, 23, and 25-28 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by US 6,251,840 to Ward (“Ward”). Applicants respectfully disagree for at least the following reasons.

Ward fails to disclose each and every limitation of currently amended pending independent claims 1, 11, 19, and 26-28 and therefore fails to anticipate those claims and those claims depending therefrom.

Independent claims 1, 11, 19, and 26-28 are directed to a power transmitting fluid for use in a transmission having steel-on-steel contact, an additive composition suitable for such a power transmitting fluid, a method of making such a power transmitting fluid, and a method of

lubricating a transmission or gear. The power transmitting fluid comprises a major amount of a base oil consisting essentially of mineral oil, and at least one thiadiazole or derivative thereof present in an amount sufficient to provide a low pulley coefficient of friction ranging from about 0.0758 to about 0.085 or greater for steel-on-steel contact as measured by a Van Doorne push-belt CVT dynamometer test. The amount of thiadiazole in the formulation to provide the indicated coefficient of friction is significantly more than is conventionally used in transmission applications.

Although Ward discloses a generic range for the thiadiazole in column 4, line 39, Ward fails to teach, suggest, or disclose the specific range of thiadiazole required to achieve the coefficient of friction achieved by applicant's invention. As set forth in the MPEP in §2131.03:

"If the claims are directed to a narrow range, and the reference teaches a broad range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims. See, e.g., Atofina v. Great Lakes Chem. Corp., 441 F.3d 991, 999, 78 USPQ2d 1417, 1423 (Fed. Cir. 2006) wherein the court held that a reference temperature range of 100-500 degrees C did not describe the claimed range of 330-450 degrees C with sufficient specificity to be anticipatory. Further, while there was a slight overlap between the reference's preferred range (150-350 degrees C) and the claimed range, that overlap was not sufficient for anticipation. '[T]he disclosure of a range is no more a disclosure of the end points of the range than it is each of the intermediate points.' Id. at 1000, 78 USPQ2d at 1424. Any evidence of unexpected results within the narrow range may also render the claims unobvious."

The Ward reference only provides specific examples containing 0.05 wt.% thiadiazole (see Table II, col. 16, line 50), which is the customary amount of thiadiazole used in such applications. Furthermore, Ward fails to teach, suggest, or disclose the benefits of adding more than the customary amount of thiadiazole to achieve higher steel-on-steel friction. Ward is mainly directed to using the customary amounts of thiadiazole to provide acceptable corrosion/anti-wear protection. An amount of 0.05 wt.% of thiadiazole, as shown in the examples in Ward, is a common or typical amount for an ATF application and the prior art is replete with examples using thiadiazole around this level or below.

It simply isn't intuitive that one could increase the coefficient of friction by increasing the level of this type of additive, i.e., one designed to impact pitting/wear and corrosion, particularly one like thiadiazole which achieves its intended effects at relatively low weight percents.

Accordingly, the increases in the coefficient of friction results shown in Table 1 were unexpected. Since Ward is manifestly deficient in teaching, disclosing, or suggesting the compositions and methods defined in currently amended pending independent claims 1, 11, 19, 26, and 28, the rejection of claims 1, 11, 19, 26, and 28 over Ward is wholly untenable and should be withdrawn.

Claims 3-7, 9-10, and 23 depend from claim 1 and claims 13-18, 25, and 27 depend from claim 11 and provide additional important limitations. These claims are patentable over Ward for the same reasons claims 1 and 11 are patentable over Ward. Reconsideration and allowance of claims 1, 3-7, 9-11, 13-19, 23, and 25-28 are hereby respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please charge Deposit Account No. 12-2355 in the amount of \$400 for the payment of two new independent claims. Further, if these calculations are incorrect, the Commissioner is hereby authorized to charge any deficiencies in fees or credit any overpayment associated with this communication to Deposit Account No. 12-2355. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 12-2355.

Respectfully submitted,

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